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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,415	01/02/2001	Paul J. Rank	0007056-0054	3147
58328	7590	07/27/2006	EXAMINER	
SONNENSCHEIN NATH & ROSENTHAL LLP FOR SUN MICROSYSTEMS P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			VAUGHN, GREGORY J	
		ART UNIT	PAPER NUMBER	2178
DATE MAILED: 07/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,415	RANK, PAUL J.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 May 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Application Background***

1. This action is responsive to applicant's response, filed on 5/2/2006.
2. No claims were amended with this response.
3. Claims 1-16 are pending in the case, claims 1 and 9 are independent claims.
4. Applicant's response filed 5/2/2006 is directed toward support for the Applicant's Declaration Under 37 CFR 1.131, said declaration filed with the response of 5/2/2006, and previously filed on 12/8/2005. The newly submitted declaration is still ineffective to overcome the art of record. See the next section, and the Response to Arguments section for a complete explanation.

Response to Declaration Under 37 C.F.R. 1.131

5. The applicant's declaration filed 5/2/2006 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the effective filing date of Rouse et al., US Publication 2002/0087620 (hereinafter Rouse). 37 CFR 1.131 states:

"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application."

Applicant bears the burden of showing facts to establish either “*reduction to practice prior to the effective date of the reference*” or showing facts to establish “*conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*”

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Rouse reference, up to the date of constructive reduction to practice (i.e. filing date of application serial number 09/754,415).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Rouse reference to either a constructive reduction to practice or an actual reduction to practice.

The declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). See MPEP 715.07.

In general proof of actual reduction to practice requires a showing that the apparatus or method actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include sketches, blueprints, photographs, reproductions of notebook entries, accompanying models, supporting statements by witnesses, interference testimony, and or prior submissions to the USPTO of Disclosure documents.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). See MPEP 715.07(b).

Also, please note that an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ

342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118

USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Also, please note the diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. See MPEP 2138.06 for the nature of the showing that the attorney must make.

In view of the patent examination rules and procedures described above, the presented combination of evidence within the declaration and exhibit A are insufficient proof of applicant's "*due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application*".

Specifically, on page 2, paragraph 6 of the declaration, applicant claims conception of the inventive subject matter, prior to the filing date of the Rouse reference. On page 2, paragraph 7 of the declaration, applicant indicates what facts are relied upon to support the conception claim, said facts in reference to Exhibit A. On page 2, paragraph 8, applicant claims reasonable diligence "*to process the invention disclosure and prepare, execute and file the '415 application*" from the period just prior to the filing date of the Rouse reference (12/29/2000) to the filing date of applicants invention (1/2/2001). Furthermore, Exhibit A of the declaration is an Inventive Disclosure Report made by the inventor, with some of the information of said report being redacted.

37 CFR 1.131 requires applicant to either "*establish reduction to practice before the effective date of the reference*" or "*conception of the invention prior*

to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application". Applicant's declaration and exhibits are clearly not directed toward showing "*reduction to practice before the effective date of the reference*", but are directed toward showing "*conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*".

Applicant's declaration and supporting exhibit fail to prove both "*the conception of the invention prior to the effective date of the reference*" and the "*due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*". The declaration and supporting Exhibit A are ineffective because of insufficient proof of due diligence, as required by 37 CFR 1.131.

Applicant's declaration clearly states that Exhibit A is relied upon to show conception (see paragraph 6 on page 2 of the declaration). Applicant does not claim that Exhibit A shows the "*due diligence*" required under 37 CFR 1.131. Although applicant claims due diligence in paragraph 8 of page 2 of the declaration, the declaration and supporting exhibits fail to clearly explain which facts or data applicant is relying on to show due diligence, as required by 37 CFR 1.131. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "*amounts essentially to mere pleading, unsupported by*

proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Applicant states in paragraph 8 on page 2 of the declaration that: "*During this time period, I and my representatives worked reasonably hard and expeditiously to process the invention disclosure and prepare, execute and file the '415 Application*". These are vague and general statements made in broad terms. Applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Applicant has not carried the burden of showing facts or data applicant is relying on to show "*due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application*".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

7. Claims 1-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Rouse et al. US Patent publication 2002/0087620, filed 12/29/2000, published 4/4/2002 (hereinafter Rouse).

8. **Regarding independent claim 1**, Rouse discloses determining a subset of functions associated with a file from a set of functions associated with an application of the file. Rouse recites: *"Design filter 314 may validate that the design elements do not contain elements that are not needed or are not supported by the destination device (e.g., mobile device). Elements not needed may be removed and elements that are not supported may result in compile and/or other errors. Script compiler 316 may convert a subset of functions and JavaScript (or other script) to WML script (or other wireless script)"* (page 4, paragraph 44). Rouse discloses downloading the file and the

subset of functions to a PDA. Rouse recites: "*Style sheet generator 318 may use XSL style sheets to generate application specific XSL style sheets that may become part of a compiled mobile application and may be used by a wireless servlet at run-time. Other types of style sheets may also be generated. Output packager 320 may store a compile output in a special mobile class. Compile output may include an application digest, style sheets and script compilation units. Other information may also be included in a compile output*" (page 4, paragraph 44). Rouse further discloses in Figure 1 at reference sign 116, a mobile server provider downloading the compile output to the wireless device (reference sign 130).

9. **Regarding dependent claim 2**, Rouse discloses determining the subset of functions based upon a user preference in Figure 2 at reference sign 216 (shown as "*User App. Preferences*").
10. **Regarding dependent claim 3**, Rouse discloses determining the subset of functions as a family of functions Rouse recites: "*a list of possible customized replies, which may include "will discuss later", "will call later" and other replies*" (page 2, paragraph 22).
11. **Regarding dependent claim 4**, Rouse discloses displaying the subset of functions as a list. Rouse discloses a listing of the subset of functions in Figure 6, at reference sign 640.

12. **Regarding dependent claim 5**, Rouse discloses using the family of functions to recognize additional functions. Rouse recites: "*Customized replies may be predetermined for varying types of actions. For example, for a stock broker, possible replies may include "buy", "sell", "hold", etc.*" (page 2, paragraph 22).
13. **Regarding dependent claim 6**, Rouse discloses a user selecting additional functions. Rouse recites: "*The mail menu screen 600 may include various viewing options which the user may select*" (page 5, paragraph 51).
14. **Regarding dependent claim 7**, Rouse discloses a family of financial functions. Rouse recites: "*For example, for a stock broker, possible replies may include "buy", "sell", "hold", etc*" (page 2, paragraph 22).
15. **Regarding dependent claim 8**, Rouse discloses prompting a user to choose whether to download the file and subset. Rouse recites: "*Viewing options may include enabling the user to choose which features (or lines) of a message that the user would like to make viewable*" (page 4, paragraph 49).
16. **Regarding claims 9-16**, the claims are directed toward a computer program for the method of claims 1-8, respectively, and are rejected with the same rationale.

Response to Arguments

17. Applicant's arguments filed 5/2/2006 have been fully considered but they are not persuasive.

18. Applicant's remarks are substantially directed toward applicant's submission of a declaration under 37 CFR 1.131. The declaration is ineffective to overcome the effective filing date of the Rouse reference, as described above.

In response to applicant's argument that "*The applicant is not required to establish reduction to practice before the effective date of Rouse*" (page 5, of the response filed 5/2/2006), the examiner respectfully agrees. However 37 CFR 1.131 requires applicant to either "*establish reduction to practice before the effective date of the reference*" or "*conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*". Applicant's declaration and exhibits are clearly not directed toward showing "*reduction to practice before the effective date of the reference*", but are directed toward showing "*conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*".

Applicant's declaration and supporting exhibit fail to prove both "*the conception of the invention prior to the effective date of the reference*" and the "*due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application*". The office action of 2/17/2006 (and maintained herein) has found the declaration and supporting Exhibit A ineffective because of insufficient proof of due diligence, as required by 37 CFR 1.131.

Applicant's declaration clearly states that Exhibit A is relied upon to show conception (see paragraph 6 on page 2 of the declaration). Applicant does not claim that Exhibit A shows the "*due diligence*" required under 37 CFR 1.131. Although applicant claims due diligence in paragraph 8 of page 2 of the declaration, the declaration and supporting exhibits fail to clearly explain which facts or data applicant is relying on to show due diligence, as required by 37 CFR 1.131. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "*amounts essentially to mere pleading, unsupported by proof or a showing of facts*" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Applicant states in paragraph 8 on page 2 of the declaration that: "*During this time period, I and my representatives worked reasonably hard and expeditiously to process the invention disclosure and prepare, execute and file the '415 Application*". These are vague and general statements made in broad terms. Applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634,

643 (CCPA 1966). See MPEP 2138.06. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Applicant has not carried the burden of showing facts or data applicant is relying on to show "*due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application*".

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Vaughn
Patent Examiner
July 20, 2006